

REMARKS

Applicant hereby responds to the Office Action dated January 2, 2008. Applicant thanks the Examiner for carefully considering the application.

Status of Claims

Claims 1-15 were, and remain currently pending. Claims 1 and 12 are independent.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,698,020 issued to Zigmond ("Zigmond") in view of U.S. Patent No. 5,838,314 issued to Neel ("Neel"). Claims 5, 12, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Neel in view of U.S. Patent No. 7,039,935 issued to Knudson ("Knudson"). Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Neel in view of U.S. Patent application Pub. No. 2004/0073947 for Gupta ("Gupta") and U.S. Patent No. 6,469,749 issued to Dimitrova ("Dimitrova"). Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond, Neel and Knudson in view of Gupta and Dimitrova.

Claim Amendments

By way of this reply, claims 1 and 12 are amended for clarification. No new matter has been added by way of this amendment and none of the amendments is made in view of prior art.

Rejections Under 35 U.S.C. 103(a)

Claims 1-4 and 6-8

Claims 1-4, and 6-8 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond in view of Neel. The rejection is respectfully traversed because for at least the following reasons, Zigmond, Neel, and any combination of the two do not disclose all of the claimed limitations.

According to MPEP §2142

[t]he key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007) noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396 (quoting Federal Circuit statement with approval).

Further, according to MPEP §2143, “[T]he Supreme Court in *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1395-1397 (2007) identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*.” And, according to MPEP §2143.01, [o]bviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006). Further, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” *KSR International Co. v. Teleflex, Inc.* 550 U.S. ___, ___, 82 USPQ2d 1385, 1396 (2007). Additionally, according to MPEP §2143

[a] statement that modification of the prior art to meet the claimed invention would have been “well within the ordinary skill of the art at the time the claimed invention was made” because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Pat. App. & Inter. 1993).

In the instant Office Action, the Examiner asserts that element 60 shown in Fig. 3 of

Zigmond is a digital television receiver performing a Digital TV function. Applicant respectfully disagrees as Zigmond discloses, for example, the ad delivery of FIG. 5 is conducted by transmitting the advertisements on a piecemeal basis during transmission of *a typical analog television broadcast*.

Further, independent claim 1 requires, in part, “*combining and outputting the plurality of the advertisement messages and the received video data as a combined output signal for simultaneously viewing the advertisement messages and the received video data*; maintaining a total count of the number of the plurality of the advertisement messages that have been output by the digital television receiver during enablement of the digital TV function of the digital television receiver; and if the count reaches a predetermined number, then *disabling the digital TV function* of the digital television receiver.” (Emphasis added).

In Zigmond, however, the advertisements are *not combined with video data into the same signal where they are output as a combined signal for simultaneously viewing the advertisement messages and the received video data*. This is clearly asserted in Zigmond as seen in FIGs. 5-6, and at: column 7, lines 25-31 “[a]t an appropriate time specified by encoded data in video programming feed 52 or by the structure of video programming feed 52, the household *advertisement insertion device 60 interrupts the display of the video programming feed 52*. An advertisement 59 that has been selected according to any desired method *is then displayed* to the viewer using display device 58” (emphasis added), column 8, lines 33-38 “[a] video switch 68 *toggles between video programming feed 52 and selected advertisements of advertisement stream 64* and transmits the selected data feed to display device 58. Video switch 68 may be actuated at an appropriate time indicated by a triggering event delivered by advertisement trigger source 70” (emphasis added), column 8, lines 44-54

when an implied triggering event is used to *initiate display of the selected advertisement*, any consistent pattern in video programming feed 52 that is associated with forthcoming advertisements may be used as the implied triggering event. For example, programming sources 66 such as national broadcasters or cable networks often

transmit a very brief black screen immediately preceding the onset of a series of advertisements. Such a pattern may be interpreted by *ad insertion device 60 and video switch 68 to be a triggering event indicating an appropriate time to insert a selected advertisement* (emphasis added),

column 15, lines 55-64

the ad insertion device 80 may *thereby determine the precise time for inserting a selected advertisement*. When switching decision unit 88 identifies the presence of a triggering signal, whether actual or implied, *it prompts video switch 90 to interrupt display of the video programming feed and to insert in its place the selected advertisement from advertisement repository 86*. Video switch 90 is but one example of means for *interrupting delivery of the video programming feed and delivering, at the appropriate time, the selected advertisement to the display device* (emphasis added),

column 16, lines 31-38 “[i]n yet another embodiment, advertisements are selected and inserted into a video programming stream without regard to the position of the conventional advertising slot. Instead of an appropriate time determined by the content of the programming or by any other desired criteria, *the video programming is interrupted and one or more selected advertisements are displayed*” (emphasis added), column 16, line 65 to column 17, line 3, “[i]n yet another embodiment, two or more appropriate advertisements are *selected for an available time slot in the video programming feed*. Each of the two or more selected advertisements is displayed at the appropriate time using a split-screen or another arrangement by which *the viewer may see both advertisements*” (emphasis added), column 17, lines 25-32 “[i]n step 112, the ad insertion device waits for a triggering event that indicates an appropriate time to insert the selected advertisement. When a triggering event is received according to decision box 114, *the video switch is activated in step 116, thereby interrupting the display of the video programming feed and displaying the selected advertisement*” (emphasis added), and column 17, lines 33-37 “[i]n an optional step, the viewer response to the displayed advertisement is monitored in step 118 according to the methods disclosed herein. *When the selected advertisement is complete, the video switch resumes transmitting the video programming feed to the display device* in step 120”

(emphasis added).

Moreover, Applicant's claim 1 requires "maintaining a *total count of the number of the plurality of the advertisement messages* that have been output by the digital television receiver during enablement of the digital TV function of the digital television receiver." On the contrary, Zigmond only discloses maintaining the number of times an advertisement is displayed for a particular viewer (Zigmond, column 13, lines 40-42).

Still further, it is asserted in the Office Action that Zigmond discloses that once an ad has been displayed a desired number of times the advertisement is blocked, which the Examiner interprets as disclosing the digital TV function is disabled. Applicant respectfully disagrees. In Applicant's claimed invention, the advertisements and the video program are combined into an output signal where both the advertisements and video program are simultaneously displayed to a viewer. That is, the digital TV function in Applicant's claimed invention relates to displaying the advertisements along with the program simultaneously, which is distinguishable from Zigmonds interrupted display of advertisements or programming. Therefore, when the digital TV function of the digital television receiver is disabled in Applicant's claimed invention, all viewing must cease as the output signal cannot be output for display, which is different from Zigmond as the programming will continue and other advertisements will continue to be displayed on an interrupted basis, albeit different from the advertisements that have ceased for the particular time period.

Neel is relied on in the Office Action for disclosing determining whether a count reaches a predetermined number, and then disabling a digital TV function. Applicant respectfully disagrees. Neel simply discloses denying access to a user if the user does not complete all questions asked during an interactive advertisement. That is, if all of the predetermined number of questions in the interactive advertisement of Neel are answered, the video access is granted. Additionally, the questions in an interactive advertisement are still related to a single advertisement. Therefore, there is no determining if a predetermined count of advertisements is

reached before disabling a digital TV function.

Even if the teachings of Neel are combined with those of Zigmond, the result would still not teach, disclose or suggest Applicant's amended claim 1 limitations as the result would still not disclose or suggest

providing a digital television receiver performing a digital TV function including receiving and outputting information; ... combining and outputting the plurality of the advertisement messages and the received video data as a combined output signal for simultaneously viewing the advertisement messages and the received video data; maintaining a total count of the number of the plurality of the advertisement messages that have been output by the digital television receiver during enablement of the digital TV function of the digital television receiver; and if the count reaches a predetermined number, then disabling the digital TV function of the digital television receiver.

Further, the assertions made in the Office Action on page 4 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP 2143 cannot be found. Additionally, since neither Zigmond, Neel, and therefore, nor the combination of the two, teach, disclose or suggest all the limitations of Applicant's claim 1, as listed above, Applicant's claim 1 is not obvious over Zigmond in view of Neel since a *prima facie* case of obviousness has not been met under MPEP §2142. Thus, claim 1 of the present application is patentable over Zigmond and Neel for at least the reasons set forth above. Additionally, the claims that directly or indirectly depend on amended claim 1, namely claims 2-4 and 6-8, are also patentable over Zigmond and Neel for the same reasons as asserted above.

Regarding Applicant's claim 2, it is asserted in the Office Action that Zigmond discloses Applicant's claim 2 limitations of "after the digital TV function has been disabled, such that video data from the digital television service provider are no longer output, storing a new set of a plurality of advertisement messages in the storage device; and subsequently enabling the digital

TV function of the digital television receiver” according to column 8, lines 29-39 and column 13 lines 40-47. Applicant respectfully disagrees. Zigmond simply discloses switching between a video stream and an advertising stream based on a triggering event (column 8, lines 29-39) and blocking a particular advertisement after the particular advertisement has been viewed by a particular user a certain number of times in a certain period of time (column 13, lines 40-47). Nowhere in the cited text of Zigmond are Applicant’s claim 2 limitations of “*storing a new set of a plurality of advertisement messages in the storage device; and subsequently enabling the digital TV function* of the digital television receiver. Thus, claim 2 of the present application is patentable over Zigmond and Neel for at least the reasons set forth above.

Regarding Applicant’s claim 4 requires “setting the *predetermined number* such that *all of the plurality of the advertisement messages that were stored will be output.*” It is asserted in the Office Action on page 5 that Zigmond discloses Applicant’s claim 4 limitations at column 14, lines 49-58. Applicant respectfully disagrees. Zigmond simply discloses that certain advertisers will have a guaranteed number of exposures. The advertisements of certain advertisers do not encompass all of the stored advertisements in Zigmond. Further, it is clear that the guarantee is so that an advertiser gets at least the guaranteed amount instead of fewer. But it does not mean there cannot be a greater amount displayed. Simply put, the guaranteed number of exposures does not equal all of the stored advertisements. Thus, claim 4 of the present application is patentable over Zigmond and Neel for at least the reasons set forth above.

Accordingly, withdrawal of the rejections of claims 1-4 and 6-8 are respectfully requested.

Claims 5, 12, 13 and 15

Claims 5, 12, 13 and 15 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Neel in view of U.S. Patent No. 7,039,935 issued to Knudson (“Knudson”). The rejection is respectfully traversed because for at least the following reasons, Zigmond, Neel, and any combination of the two do not disclose all of the claimed limitations.

Applicant's claim 5 directly depends on amended claim 1. As asserted above, neither Zigmond, Neel, nor any combination, teach, disclose or suggest Applicant's amended claim 1 limitations. Knudson is relied on for disclosing advertising banners in conjunction with video. However, the banners in Knudson are not combined with the video in an output signal. That is, even if Knudson is combined with the teachings of Zigmond and Neel, the result would still not teach, disclose or suggest Applicant's amended claim 1 limitations of "*combining and outputting the plurality of the advertisement messages and the received video data as a combined output signal for simultaneously viewing the advertisement messages and the received video data.*"

Applicant's amended claim 12 requires in part "an output terminal connected to said video reconstruction unit for receiving the combined video output signal and for *outputting the combined video output signal, wherein the selected program and rendered data are simultaneously output in the video output signal for simultaneously viewing the advertisement messages and the received video data.* Similarly as asserted above with regard to claim 1, even if Zigmond is combined with Neel and Knudson, the result would still not combine the banner advertisements with programming in an output signal for simultaneous viewing, as required by independent claim 12.

Further, the assertions made in the Office Action on page 7 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP 2143 cannot be found. Additionally, since neither Zigmond, Neel, Knudson, and therefore, nor the combination of the three, teach, disclose or suggest all the limitations of Applicant's claims 1 and 12, as listed above, Applicant's claims 1 and 12 are not obvious over Zigmond and Neel in view of Knudson since a *prima facie* case of obviousness has not been met under MPEP §2142. Thus, claims 1 and 12 of the present application are patentable over Zigmond and Neel in view of Knudson for at least the reasons set forth above. Additionally, the claims that directly or indirectly depend on amended claims 1 and 12, namely claims 5, 13 and 15, respectively, are also patentable over Zigmond and Neel in view of Knudson for the same reasons as asserted above.

Accordingly, withdrawal of the rejections of claims 5, 12, 13 and 15 are respectfully requested.

Claims 9-11

Claims 9-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond and Neel in view of U.S. Patent Application Pub. No. 2004/0073947 (“Gupta”) and U.S. Patent No. 6,469,749 issued to Dimitrova. Gupta was filed January 31, 2001, and declared invented by January 18, 2001 in a declaration, which is clearly after the priority date of the present application. Thus, the rejection with regard to Gupta is improper and must be withdrawn.

Regardless, Applicant’s claims 9-11 indirectly depend on amended claim 1. As asserted above, the combination of Zigmond and Neel does not teach, disclose or suggest Applicant’s amended claim 1 limitations of “*combining and outputting the plurality of the advertisement messages and the received video data as a combined output signal for simultaneously viewing the advertisement messages and the received video data; maintaining a total count of the number of the plurality of the advertisement messages that have been output by the digital television receiver during enablement of the digital TV function of the digital television receiver; and if the count reaches a predetermined number, then disabling the digital TV function of the digital television receiver.*” Further, Gupta discloses insertion of advertisements while video content is not displayed and uses a timer and Dimitrova uses a temporal relationship policy using counters to determine type of advertisement.

No combinations of Zigmond, Neel, Dimitrova and even Gupta (although Applicant asserts Gupta is not a proper prior art reference) teach, disclose or suggest Applicant’s amended claim 1 limitations, as listed above.

Further, the assertions made in the Office Action on pages 10-11 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP

2143 cannot be found. Additionally, since neither Zigmond, Neel, Dimitrova, (and Gupta if Gupta were a proper prior art reference) and therefore, nor the combination of the four, teach, disclose or suggest all the limitations of Applicant's claim 1, as listed above, Applicant's claim 1 is not obvious over Zigmond and Neel in view of Dimitrova (and Gupta if Gupta were a proper prior art reference) since a *prima facie* case of obviousness has not been met under MPEP §2142. Thus, claim 1 of the present application are patentable over Zigmond and Neel in view of Dimitrova (and Gupta if Gupta were a proper prior art reference) for at least the reasons set forth above. Additionally, the claims that directly or indirectly depend on amended claim 1, namely claims 9-11, are also patentable over Zigmond and Neel in view of Dimitrova (and Gupta if Gupta were a proper prior art reference) for the same reasons as asserted above.

Accordingly, withdrawal of the rejections of claims 9-11 are respectfully requested.

Claim 14

Claim 14 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond, Neel and Knudson, in view of Gupta and Dimitrova. As discussed earlier, Gupta is not a proper prior art reference. Thus, the rejection is improper and must be withdrawn.

Regardless, Applicant's claim 14 directly depends on amended claim 12. As discussed above, Zigmond in view of Neel does not teach, disclose or suggest Applicant's amended claim 12 limitations of "an output terminal connected to said video reconstruction unit for receiving the combined video output signal and for *outputting the combined video output signal, wherein the selected program and rendered data are simultaneously output in the video output signal for simultaneously viewing the advertisement messages and the received video data.*"

Therefore, even if Zigmond, Neel and Knudson are combined with Dimitrova (and Gupta if Gupta were a proper prior art reference), the result would still not combine the banner advertisements with programming in an output signal for simultaneous viewing, as required by

independent claim 12.

Further, the assertions made in the Office Action on page 12 that lead to a conclusion of obviousness are not explicit and the basic requirements of an articulated rationale under MPEP 2143 cannot be found. Additionally, since neither Zigmond, Neel, Knudson, Dimitrova, (and Gupta if Gupta were a proper prior art reference), and therefore, nor the combination of the four (or five if Gupta were a proper prior art reference), teach, disclose or suggest all the limitations of Applicant's claim 12, as listed above, Applicant's claim 12 is not obvious over Zigmond, Neel and Knudson in view of Dimitrova (and Gupta if Gupta were a proper prior art reference) since a *prima facie* case of obviousness has not been met under MPEP §2142. Thus, claim 12 of the present application is patentable over Zigmond, Neel and Knudson in view of Dimitrova (and Gupta if Gupta were a proper prior art reference) for at least the reasons set forth above. Additionally, the claim that directly depends on amended claim 12, namely claim 14, is also patentable over Zigmond, Neel and Knudson in view of Dimitrova (and Gupta if Gupta were a proper prior art reference) for the same reasons as asserted above.

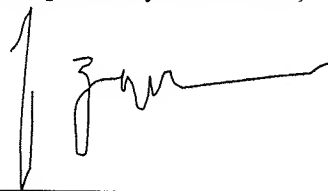
Accordingly, withdrawal of the rejections of claim 14 is respectfully requested.

CONCLUSION

For these and other reasons, it is respectfully submitted that the rejection of the rejected claims should be withdrawn, and all of the claims be allowed. Accordingly, reexamination, reconsideration and allowance of all the claims are respectfully requested. If the Examiner believes that a telephone interview will help further the prosecution of this case, Applicant respectfully requests that the undersigned attorney be contacted at the listed telephone number.

Please direct all correspondence to **Myers Dawes Andras & Sherman LLP**, 19900 MacArthur Blvd., Suite 1150, Irvine, California 92612.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Zarrabian', written over a horizontal line.

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